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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/994,723	11/28/2001	Satoshi Nishikawa	35.G2949	8316
5514	7590	01/27/2006	EXAMINER	
FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			QIN, YIXING	
			ART UNIT	PAPER NUMBER
			2622	
DATE MAILED: 01/27/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/994,723

Applicant(s)

NISHIKAWA ET AL.

Examiner

Yixing Qin

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 October 2005.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 6-10, 16-20, 26-30 and 32 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☐ Claim(s) 6-10, 16-20, 26-30 and 32 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 28 November 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 10/24/05.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

In response to applicant's amendment received 10/24/05 all requested changes have been entered.

Response to Arguments

Applicant's arguments filed 10/24/05 have been fully considered but they are not persuasive. The two main points being argues is that the references, Miyake and Holt, either alone or in combination do not disclose the determination of physical or printable region n-page printing and there is no generation means based upon the determined physical or printable n-page printing. The Examiner believes the references indeed teach/suggest such features. Miyake discloses in Figs. 2A-2E n-page prints that correspond to the printable region n-page format. The Holt references expands on this and shows in Figs. 14A-C different output formats. One can recognize 14A as a printable region n-page format and 14C as the physical n-page format where the pages are centered in the divided areas. From Holt, column 17, lines 56-57, one can refer to Figs. 11-13 to see the different pagination routines used to create the outputs in Figs. 14A-C.

As for the generation unit, Holt discloses in the abstract that his invention is an object oriented printing interface that can paginate information that include, amongst other things, n-up printing. The interface appears to be an improved version of a print driver as is apparent from the prior art Figs. 1 and 2 and Fig. 4 (which represents Holt's invention). The interface unit would be able to read on the generation unit since it is

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able to paginate information in two different formats as seen in Fig. 14A-C. It would be obvious to one of ordinary skill that the determination of which format is to be printed is based upon various criteria set in a program, which one can see bits and pieces of throughout the entire reference in the various tables and italicized fonts. Thus, the Examiner believes the references do indeed show the features of the invention as currently claimed. Please see the rejection below.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 9 and 19 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claims 9 and 19 are directed to information of a predetermined sheet which is premised that a printed sheet is cut into N-sheets. However, there is insufficient support in the specification as the cutting of sheets except a brief description on page 3 of the specification, which is only describing the background of the invention and not of the invention itself.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

I. Claims 6-10, 16-20, 26-30 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Holt (U.S. Patent No. (5,495,561).

6. Claims 6, 16, 26 and 32

- Holt in Fig. 14A-C different layouts that can be printed. Holt discloses in column 17, lines 56-67 and column 18, lines 1-9 that the MacDraw program can output these different layouts.
- These are all outputs of various routines that MacDraw can perform, and it would be obvious that a determination would be made for which routine to perform based on the type of the output that is needed. Holt also discloses in column 32, lines 8-66 a printing example of printing four pages on one page (lines 8-11). Lines 38-52 discloses the use of various functions to define the page size and printable area, which is analogous to determining which type of N-page printing is performed (physical or printable region).
- As mentioned above in the response to the arguments, the Holt reference does teach/suggest the newly added limitation of the generation means/step because the print interface (similar to a print driver) takes care of this process. It would be obvious that determination occurs because there can be at least the two types of output formats shown in Figs. 14A-C.

7. Claims 7, 17 and 27

- Again, from Holt, column 32, lines 51-63, one can see that various rectangular coordinates (i.e. **conditions**) for determining the page size and printable area is used. The **condition acquiring means** can be the program or function that gets these variables. It would be obvious that, depending on the coordinates put in, the images on the page can be manipulated to look like the ones in Holt, Fig. 14, which is analogous to the physical and printable region N-page layouts being claimed.

8. Claims 8, 18 and 28

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- Again, from claim 6 above, the example given said there was to be four copies that was to appear on one page. This combined with the condition information as explained in claim 7 above meets the limitations of this claim.

9. Claims 9, 19

- The cutting of paper is well known (see page 3 of the specification) and would be obvious to one of ordinary skill to incorporate information regarding the cutting of sheets as a printing condition, if needed.
- As explained above in claim 6, one can see various information that is designated in, for example, Figs. 11-13 of Holt. The determined result from this can be seen in Fig. 14A-C. It would be obvious there can be various predetermined output sheet information (such as size).

10. Claims 10, 20 and 30

- Although Holt does not go into much detail about an external device providing information, the input of information from an external device (such as a print server) is well-known.

11. Claim 29

- As explained above in claim 6, one can see various information that is designated in, for example, Figs. 11-13 of Holt. The determined result from this can be seen in Fig. 14A-C. One of the pieces information that is needed would be the size, as is apparent from column 12, line 18 of Holt.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yixing Qin whose telephone number is (571)272-7381. The examiner can normally be reached on M-F 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Coles can be reached on (571)272-7402. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

YQ



EDWARD COLES
SUPERVISOR